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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL E. FORD and JIM A. BAUMGARTNER

Appeal 2009-010987
Application 10/765,304
Technology 2400

Before MAHSHID D. SAADAT, ERIC B. CHEN,
and BRUCE R. WINSOR, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-37, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

STATEMENT OF THE CASE

Introduction

Appellants' invention relates to methods, systems, and devices for analyzing a number of device drivers and determining the driver to be used with a device. A portion of the interface for driver selection is delegated to the drivers themselves so that the drivers become active participants in selecting the appropriate driver for a device. *See Spec. 6:23-28.*

Exemplary independent claims 1 and 29 read as follows:

1. A management station, comprising:
 - a processor;
 - memory in communication with the processor; and
 - program instructions stored in the memory and executable on the processor to:
 - initiate execution of a particular device function that will use a driver;
 - select a set of drivers based upon defined device information; and
 - call a routine in a particular driver from the selected set of drivers which executes to determine whether the particular driver is most appropriate to perform the particular device function for a particular device.
29. A computer readable storage medium having program instructions that are executed by a computing device to cause a device to perform a method, comprising:
 - initiating execution of a particular device function that will use a driver;
 - selecting a set of drivers based upon defined device information; and
 - calling a routine in a particular driver from the selected set of drivers which executes to determine whether the particular driver is most appropriate to perform the particular device function for a particular device.

Rejections

1. The Examiner rejected claims 30-32 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.¹

2. The Examiner rejected claims 1-7, 9-11, 13, 14, 16-24, 28-30, and 33-37 under 35 U.S.C. § 102(e) as being anticipated by Moore (US 2004/0003135 A1).

3. The Examiner rejected claims 15, 25, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Moore.

4. The Examiner rejected claims 12, 26, 31, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Moore and Philyaw (US 6,704,864 B1).²

Appellants' Contentions

35 U.S.C. § 101 Rejection

Appellants contend that the Examiner erred in rejecting claim 30-32 under 35 U.S.C. § 101 because the recited computer executable instructions reside in a memory, as disclosed in lines 10-15 on page 9 of the Specification (App. Br. 17). Appellants further indicate their willingness to amend the rejected claims to include appropriate language in the preamble of the claims (App. Br. 18, Reply Br. 2).

35 U.S.C. § 102 Rejection

Appellants contend that the Examiner erred in rejecting claims 1, 16, and 29 under 35 U.S.C. § 102(e) as being anticipated by Moore because the

¹ The Examiner does not find the nonstatutory language in the preamble of independent claim 29 and merely focuses on “the computer readable medium” in the preamble of claims 30-32.

² Claim 8 is omitted from the list of rejected claims. However, the cover page of the Final Rejection lists claims 1-37 as the claims rejected.

reference does not teach a processor to “call a routine in a particular driver from the selected set of drivers which executes to determine whether the particular driver is most appropriate to perform the particular device function for a particular device” (App. Br. 18-22, Reply Br. 2-7).

ISSUES

1. Did the Examiner err in rejecting claims 30-32 under 35 U.S.C. § 101 because these claims are directed to statutory subject matter?
2. Did the Examiner err in rejecting claims 1-7, 9-11, 13, 14, 16-24, 28-30, and 33-37 under 35 U.S.C. § 102(e) because Moore does not teach limitations required by these claims?
3. Did the Examiner err in rejecting claims 12, 15, 25-27, 31, and 32 under 35 U.S.C. § 103(a) because Moore does not teach limitations required by these claims?

PRINCIPLES OF LAW

Under the Patent Act of 1952, subject matter patentability is a threshold requirement. “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101.

In *Nuijten*, our reviewing court emphasized that:

A transitory, propagating signal like Nuijten’s is not a “process, machine, manufacture, or composition of matter.” Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.

In re Nuijten, 500 F.3d 1346, 1357 (Fed. Cir. 2007). Subsequent to the court's decision in *Nuijten*, the USPTO has issued additional guidance.³ Specifically, the USPTO guidance states:

The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2.

The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals per se, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter. In an effort to assist the patent community in overcoming a rejection or potential rejection under 35 U.S.C. § 101 in this situation, the USPTO suggests the following

³ *See* David J. Kappos, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010); *see also* U.S. Patent & Trademark Office, *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, available at http://www.uspto.gov/patents/law/comments/2009-08-25_interim_101_instructions.pdf, Aug. 2009, at 2.

approach. A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim. Cf. *Animals - Patentability*, 1077 Off. Gaz. Pat. Office 24 (April 21, 1987) (suggesting that applicants add the limitation "non-human" to a claim covering a multi-cellular organism to avoid a rejection under 35 U.S.C. § 101).

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments (Appeal Brief and Reply Brief) that the Examiner has erred.

With respect to the claim rejection under 35 U.S.C. § 101, we disagree with Appellants' conclusions. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. However, we reach the opposite conclusion with respect to the claim rejections over Moore.

35 U.S.C. § 101 Rejection

We understand the Examiner's position to be based on interpreting the recited "computer readable medium" in claims 30-32 as implying either a storage medium or a transmission medium which falls into a non-statutory category (Ans. 12). Appellants rely on lines 10-15 at page 9 of the Specification (App. Br. 17) for describing instructions that reside in memory, but do not clearly establish that the program instructions are stored on a computer readable storage medium rather than existing in a distributed system which requires the instructions to be transmitted as signals to the computing device. Therefore, we agree with the Examiner that claims 30-32

encompass both statutory and non-statutory subject matter, and are therefore ineligible under § 101. Signals or carrier waves are unpatentable under § 101. *Nuijten*, 500 F.3d at 1357.

35 U.S.C. § 102(e) Rejection

We agree with Appellants as to their contention challenging the anticipatory teachings in Moore. As argued by Appellants (App. Br. 21), the software components New Device Dynamic-Linked Library (NEWDEV) 210 and Setup Application Programming Interface (SETUP) 220 are routines that initiate the installation of a driver and perform device driver installation tasks such as searching the driver information (INF), respectively (*see* Moore, ¶ [0026]). As such, these routines, which are used for installing drivers, are not in a particular driver that is called to determine whether the particular driver is most appropriate to perform the particular function for a particular device, as recited in the independent claims. We further agree with Appellants (Reply Br. 2-3) that ranking the drivers described in paragraph [0035] of Moore merely indicates how well the driver matches the device, but includes no routine in a driver that is called to evaluate the driver.

CONCLUSIONS

1. The Examiner did not err in rejecting claims 30-32 as being unpatentable under 35 U.S.C. § 101.
2. The Examiner erred in rejecting claims 1-7, 9-11, 13, 14, 16-24, 28-30, and 33-37 as being unpatentable under 35 U.S.C. § 102(e).
3. The Examiner erred in rejecting dependent claims 12, 15, 25-27, 31, and 32 as being unpatentable under 35 U.S.C. § 103(a).

DECISION

The Examiner's decision rejecting claims 30-32 under 35 U.S.C. § 101 is affirmed.

The Examiner's decision rejecting claims 1-7, 9-11, 13, 14, 16-24, 28-30, and 33-37 under 35 U.S.C. § 102(e) and rejecting claims 12, 15, 25-27, 31, and 32 under 35 U.S.C. § 103(a) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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